

REMARKS

Applicant respectfully requests reconsideration of this application, as amended herein. Claims 1-4, 6-7, and 9-21 were pending in the application. Claims 9-13 have been canceled, Claims 1, 14, and 19 have been amended for further clarification. Therefore, Claims 1-4, 6-7, and 14-21 are pending in the application.

The Examiner objected to Claims 9-13 as being of improper dependent form. As Applicant has canceled Claim 9-13 herein, Applicant respectfully requests the objection be withdrawn.

The Examiner rejected Claims 1-4, 6-7, and 9-21 under 35 U.S.C. § 112 as being indefinite. As Applicant has canceled Claim 9-13 herein, it is respectfully submitted that the instant rejection is now moot with respect to those claims. With respect to the remaining claims, Applicant has amended Claims 1, 14, and 19 to clarify that the COMBINED style includes matching elements in DISORDER and matching elements IN ORDER. Applicant respectfully asserts that the foregoing amendments put the claims in condition for allowance. Applicant respectfully requests reconsideration of the amended claims.

The Examiner rejected Claims 1-4, 6-7, and 9-21 under 35 U.S.C. 103(a) as being unpatentable over Travis et al. [US5380007] in view of the DC Lottery's "DC Lucky Numbers." Applicant respectfully traverses the rejection. As Applicant has canceled Claim 9-13 herein, it is respectfully submitted that the instant rejection is now moot with respect to those claims. The Examiner acknowledges that nothing in Travis et al. teaches or even suggests that the player can select the style of game being played including matching elements IN ORDER, in DISORDER or a COMBINATION of elements in DISORDER and IN ORDER. The Examiner then found and unrelated reference to combine with the Travis et al. reference. To establish a *prima facie*

case of obviousness, there must be some teaching, suggestion, or motivation, either in the references themselves or in a convincing line of reasoning with knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See* Manual of Patent Examining Procedure (MPEP) §2144; *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985). There is no motivation, whatsoever, either in Travis et al. or in the DC Lottery game description and rules to combine the reference teachings. Therefore, Applicant respectfully traverses the rejection.

Additionally, while the DC Lottery game allows a win for matching all the selected numbers in the wrong order, the DISORDER embodiment of the present invention provides a win for matching less than all elements in a different position. In fact, in the present invention, it is possible to obtain a win by matching none of the selected elements, because the probability of such an event is included in the Table of Values (page 18, lines 4-6). In all cases of the DC Lottery, all the digits must match to obtain a win. Even the “Front Pair” and “Back Pair” must have the matching digits in the proper order. This is quite different from the DISORDER style described in the present invention.

Furthermore, it is not possible to tell what the Combo option requires in the DC Lottery. However, the COMBINATION embodiment of the present invention provides an extra win for, not only matching all the selected elements, but for matching all the elements IN ORDER (page 14, lines 13-15). There is no suggestion that the DC Lottery permits such an additional winning option. Accordingly, Applicant respectfully traverses the rejection.

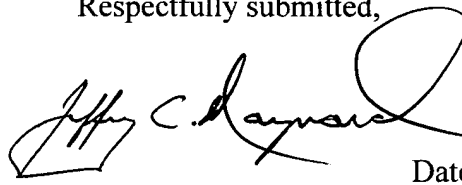
The Examiner rejected Claims 15 and 18 under 35 U.S.C. 103(a) as being unpatentable over Travis et al. in view of the DC Lottery’s “DC Lucky Numbers” and further in view of Morro et al. [US5947820]. Applicant respectfully traverses the rejection. The Examiner

suggests that it would have been obvious to use a touch sensitive video screen in the Travis et al. gaming machines. Claims 15 and 18 depend from Claim 14 and incorporate the same limitations as Claim 14, which, as described above, is patentably distinguished from the references. Thus, Claims 15 and 18 are patentably distinguished.

CONCLUSION

Applicant has made a diligent effort to address the objections identified by the Examiner and believe all claims remaining in the application are allowable. Accordingly, a Notice of Allowability is respectfully requested. However, if the Examiner is of the opinion that the present application is not in condition for allowance, Applicant respectfully requests that the Examiner contact Applicant's attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,

 11/4/04
Date

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